

BASIS FOR THE AMENDMENT

Claims 1, 3-8, 10-14 and 16-22 are active in the present application. Claims 2, 9 and 14 are canceled claims. Claims 7 and 20 are amended to depend from Claims 1 and 14, respectively. Claims 21-25 are new claims. Support for the new claims is found in the Examples. Support for new Claims 23-25 is provided by Table 1 on page 12 of the specification which discloses that the monoalkyl maleate graft polymer of the maleic anhydride/ α -olefin copolymer contains only portions of a maleic anhydride, an α -olefin and a monoalkyl maleate.

No new matter is added.

REQUEST FOR RECONSIDERATION

Independent Claims 1, 8 and 14 now require that the claimed inventions include a glycol monoalkyl ether. None of the prior art relied upon by the Office describes a composition containing all of the components recited in present independent Claims 1, 8 and 14. The presently claimed invention is therefore not anticipated by the cited prior art.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §102(b).

The Office rejected original Claims 2, 9 and 15 as obvious in view of Nadolsky (U.S. 6,841,592) and Ohta (U.S. 5,954,866), or in the alternative, in view of the combination of Schwarz (U.S. 6,433,039) with Wild (U.S. 5,310,806) or Ueda (U.S. 4,810,612). It appears that the Office is of the opinion that the presently claimed invention is obvious because the secondary prior art (e.g., Ohta, Ueda and/or Wild) disclose the presence of a glycol monoalkyl ether in ink compositions. Applicant traverses the rejection in view of the following remarks and further in view of the Declaration submitted under 37 C.F.R. §1.132.

At the outset, the Office should note that none of the prior art of record discloses or recognizes that a glycol monoalkyl ether may aid the solubilization of a maleic anhydride/ α -olefin copolymer. Applicant submits that the glycol monoalkyl ether recited in the present independent claims may serve to solubilize the resin fraction of the claimed compositions and thereby provide an ink of improved performance characteristics.

Applicant draws the Office's attention to the Declaration Under 37 C.F.R. §1.132. The Declaration describes the preparation and characteristics of three inks (i.e., Inks A, B and C). Ink A is according to the invention. Inks B and C use dipropylene glycol and propylene glycol, respectively, in place of the diethylene glycol monobutyl ether (e.g., the glycol monoalkyl ether) of inventive Ink A. Ink A therefore includes a glycol monoalkyl ether,

whereas Inks B and C do not include the glycol monoalkyl ether recited in the present independent claims.

Table 1 on page 4 of the Declaration compares the characteristics of an image formed with the ink of the invention with two comparative inks that do not contain a glycol monoalkyl ether. The inventive ink is able to provide good discharge characteristics, good water resistance and good fixation. In comparison, the discharge characteristics, water resistance and fixation properties of comparative Inks B and C are either poor or fair. Applicant submits that the Declaration proves that the composition recited in the present independent claims is significantly superior to the prior art compositions.

Applicant submits that the presently claimed invention which requires the presence of a glycol monoalkyl ether is patentable over the prior art for reasons, *inter alia*, that the claimed invention provides significantly superior performance characteristics in comparison to prior art compositions that do not contain all of the components required to be present in the claims of the present application.

Moreover, Applicant submits that Nadolsky discloses that it is known in the prior art that the use of pigments is undesirable. For example:

A third method for achieving a water fast ink involves the use of pigments rather than dyes. There are several shortcomings to this approach. For one, it is difficult to obtain and maintain pigments in a sufficiently finely divided state in the ink that they do not block the fine orifices (on the order of 25 microns in diameter) of the print heads. In addition, the color range obtainable with pigments is more limited with dyes. (column 1, lines 49-56).

Applicant thus submits that the presently claimed invention is not obvious in view of Nadolsky in combination with any of the other cited prior art for the reason that Nadolsky discloses that it is known in the prior art that pigments (such as the pigments recited in the present claims) provide inferior inks.

Applicant requests withdrawal of the rejections made in view of Nadolsky.

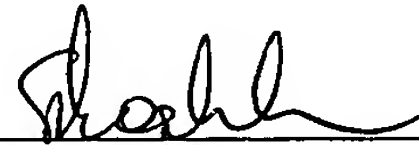
The Office asserts that Schwarz discloses the maleic anhydride/ α -olefin copolymer of the claimed invention. Applicant submits, however, that Schwarz discloses a maleic anhydride/ α -olefin copolymer that has polyethylene oxide chains (see column 9, line 43 through column 10, line 26). In this regard, Applicant draws the Office's attention to new dependent Claims 23-25 wherein the maleic anhydride/ α -olefin copolymer of the claimed invention is one that consists of only maleic anhydride, α -olefin and maleate portions. Because the maleic anhydride/ α -olefin copolymer of the new dependent claims excludes the maleic anhydride-containing polymer of Schwarz, Applicant submits that the subject matter of at least new dependent Claims 21-25 must be patentable over Schwarz.

With respect to Wild and Ueta, Applicant points out that neither of the two aforementioned prior art references discloses an inkjet ink. Instead, Ueta discloses a heat-fixable electrophotographic toner composition and Wild discloses a coating composition. Applicant submits that those of ordinary skill in the art would have no motivation for combining either or both of Ueta and Wild with the disclosure of the inkjet of Schwarz to arrive at the presently claimed invention. Therefore, notwithstanding the Declaration submitted concurrently herewith, Applicant submits that the present independent claims are not obvious in view of Schwarz, Ueta and Wild on the ground that there is no motivation to combine the cited prior art to arrive at the claimed invention.

For the reasons stated above, Applicant submits that all now-pending claims are in condition for allowance. Applicant requests withdrawal of the rejection and the allowancing of all now-pending claims.

Respectfully submitted,

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